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IN THE UNITED STATES PATENT & TRADEMARK OFFICE TECH CENTER 1600/29

IN RE APPLICATION OF :
BETTINA MOECKEL, ET AL. : EXAMINER: HUTSON, RICHARD G.
SERIAL NO: 09/919,932 :
FILED: AUGUST 2, 2001 : GROUP ART UNIT: 1652
FOR: NUCLEOTIDE SEQUENCES :
WHICH CODE FOR THE METY
GENE

RESPONSE TO REQUIREMENT FOR RESTRICTION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Official Action of March 27, 2003, Applicants elect, with traverse, Group I, Claims 1-7 and 21, drawn to an isolated polynucleotide which encodes a protein (SEQ ID NO: 2), and host cells comprising said polynucleotide.

REMARKS

The Office has required restriction in the present application as follows:

Group I: Claims 1-7 and 21, drawn to an isolated polynucleotide which encodes a protein (SEQ ID NO: 2), and host cells comprising said polynucleotide;

Group II: Claims 8 and 20, drawn to a *Corynebacterium glutamicum* strain;

Group III: Claims 9-19, 22-24, and 25-37, drawn to a method of production of an L-amino acid;

Group IV: Claims 38-39, drawn to an animal feedstuff; and

Group V: Claim 40, drawn to a method of obtaining a cDNA or RNA.

Restriction is only proper if the claims of the restricted group are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. M.P.E.P. § 803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office has characterized the inventions of Groups I, II, and IV as “structurally unrelated.” Citing M.P.E.P. § 806.04 and 808.01, the Office suggests that the “polynucleotides of Groups I and the *Coryneform glutamicum* strain of Groups II [sic: Group II] each comprise a chemically unrelated structure capable for separate manufacture, use and effect. The polynucleotides of Group I are comprised of a nucleic acid sequence and the animal feedstuff of Group IV are comprised of L-methionine and the *Coryneform glutamicum* strain of Groups II [sic: Group II] is a living cell comprising polynucleotides, proteins, carbohydrates and lipids. The polynucleotides have other utility besides encoding protein such as a hybridization probe.” However, Applicants respectfully submit that the Office has merely made conclusory statements and has not provided evidence to suggest that these groups are “structurally unrelated,” as alleged.

Applicants note that the M.P.E.P. describes unrelated inventions as, for example, “an article of apparel such as a shoe, and a locomotive bearing,” or “a process of painting a house of a process of boring a well.” M.P.E.P. § 806.04(a). Thus, unrelated inventions, as defined by the M.P.E.P., are inventions which are directed to *completely* different technical fields, and have no reasonable relationship with each other. Applicants make no statement regarding the patentable distinctness of the inventions of Groups I, II, and IV, but note, for example, that the inventions of Groups I, and II are classified in the same class and subclass, and therefore cannot reasonably be deemed as directed to *completely* different technical

fields, as discussed above. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office has characterized the inventions of Groups II and III as related as product and process of use. Citing M.P.E.P. § 806.05(h), the Office suggests that “the bacteria of Group II can be used in a materially different process such as one in which the bacteria are used to synthesize and characterize a nucleic acid.” However, there is no evidence of record to show that the claimed bacteria can be used in this manner, nor has the Office shown that the proposed use “to synthesize and characterize nucleic acid” is materially different from what is claimed. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and should therefore be withdrawn.

The Examiner also asserts that the inventions of Groups I and III are “unrelated” and alleges that the invention of Group I is “neither used nor made by the method of Group III.” First, the Office has provided no reasoning to support the latter assertion. Furthermore, as discussed above, M.P.E.P. § 806.04(a) teaches that unrelated inventions are directed to *completely* different technical fields. Applicants make no statement regarding the patentable distinctness of the inventions of Groups I and II. However, the inventions of Groups I and II are classified in the same class, and therefore cannot reasonably be considered to be directed to *completely* different technical fields. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

The Office has characterized the inventions of Groups IV and III as related as process of making and product made. Citing M.P.E.P. § 806.05(f), the Office concludes that the product “can be made synthetically (chemically).” However, there is no evidence of record to show that the claimed animal feedstuff can be made “synthetically” or that a “synthetic” process would be materially different from the claimed process. Accordingly, Applicants

respectfully submit that the requirement for restriction is improper, and it should be withdrawn.

The Office has characterized the inventions of Groups I and V as related as product and process of use. The Office states that the “polynucleotide of Group I can be used in a materially different process such as one which is used to synthesize the encoded proteins.” However, there is no evidence of record to show that the polynucleotide of Group I “could be used to synthesize the encoded proteins.” Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and it should be withdrawn.

The Office has characterized the inventions of Groups II and IV as being “unrelated” to the invention of Group V, “because they are neither used nor made by the method of Group V.” Again, as discussed above, Applicants note that M.P.E.P. § 806.04(a) describes “unrelated” inventions as being directed to *completely* different technical fields. Applicants make no statement regarding the patentable distinctness of the inventions of Groups II, IV and V. The inventions of Groups II and V, however, are classified in the same class, and therefore cannot reasonably be considered to be directed to *completely* different technical fields. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

Similarly, the Office characterizes the inventions of Groups III and V as “independent as they comprise different steps, utilize different products and produce different results.” However, Applicants respectfully submit that the inventions of Groups III and V cannot be considered “independent” because the term “independent” means “that there is no disclosed relationship between the two or more subjects disclosed.” M.P.E.P. § 802.01. Applicants note that the inventions of Groups III and V are both classified in the same class. Applicants make no statement regarding the patentable distinctness of the inventions of Groups III and V, but respectfully submit that the Office has failed to establish that the inventions of Groups

III and V are "independent" as defined by M.P.E.P. § 802.01. Accordingly, Applicants respectfully request withdrawal of the requirement for restriction.

Applicants respectfully submit that the present application is now in condition for examination on the merits, and early notification thereof is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

N. A. Oblon

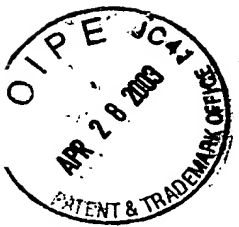
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Docket No.: 211707US0X

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WASHINGTON, D.C. 20231

ATTORNEYS AT LAW

RE: Application Serial No.: 09/919,932
Applicants: Bettina MOECKEL, et al.
Filing Date: August 2, 2001
For: NUCLEOTIDE SEQUENCES WHICH CODE FOR
THE METY GENE
Group Art Unit: 1652
Examiner: Richard G. HUTSON

SIR:

Attached hereto for filing are the following papers:

Response to Requirement for Restriction (5 pp.)

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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